


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number	Filed
		09/890,805	August 30, 2001
		First Named Inventor	
		Serge RESTLE et al.	
		Art Unit	Examiner
		1617	Leonard M. WILLIAMS
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.</p> <p><input type="checkbox"/> attorney or agent of record. Registration number <u>41,469</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p> _____ Signature</p> <p><u>Mark D. Sweet</u> _____ Typed or printed name</p> <p><u>202.408.4162</u> _____ Telephone number</p> <p><u>May 23, 2008</u> _____ Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p>			

<input type="checkbox"/> *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
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Applicants request a pre-appeal brief panel review of the rejections set forth in the Final Office Action dated December 27, 2007 ("Final Office Action"). This request is being filed concurrently with a Notice of Appeal under 37 C.F.R. § 41.31, the appropriate fee, and a completed form PTO/SB/33. No amendments are being filed with this Request.

The Examiner has rejected claims 24, 34-37, 49, 51, 74 and 75 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,139,781 to Birtwistle et al. ("*Birtwistle*"). Final Office Action at 5. Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, (Fed. Cir. 1987).

Further, a rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587, (CCPA 1972). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, (Fed. Cir. 1989).

In order to anticipate the claimed invention, *Birtwistle* must clearly and unequivocally teach the claimed composition to one of ordinary skill in the art "without any need for picking, choosing and combining various disclosures." *In re Arkley*, 455 F.2d at 587, 172 USPQ at 526. In the present case, *Birtwistle* discloses

[a] composition suitable for topical application to the skin or hair [comprising] a. a monoalkyl or monoalkenyl phosphate surfactant, b. a dialkyl or dialkenyl phosphate surfactant; and

c. a co-surfactant chosen from alkylamidopropyl betaines and alkylamphoglycinates.

Birtwistle Abstract. *Birtwistle* discloses that those compositions can further comprise a host of optional ingredients. See *Birtwistle* col. 5, line 25-col. 11. line 43. Indeed, over one hundred components are listed for the “optional ingredients” alone.

Thus, in order for one of ordinary skill in the art to attempt to arrive at the invention recited in independent claims 24, 49, and 74, the skilled artisan would need to “pick and choose” from hundreds, if not thousands, of potential cosmetic compositions. Due to this large number of potential permutations, one of skill in the art would not “at once envisage” the presently claimed combination. See M.P.E.P. § 2132. The anticipation rejection should be withdrawn for this reason alone.

Furthermore, *Birtwistle* does not expressly or inherently teach a product or a composition comprising, in relevant part, “at least one water-insoluble carboxylic acid ester...ranging **from 1.2 to 8% by weight** with respect to the total weight of the composition ...” See e.g., claims 24, 49, and 74 (emphasis added). Those components that the Examiner points to as falling within the recited “at least one water-insoluble carboxylic acid ester” claim element are among a list of 58 possible emollients or a broad class of supplemental surfactants. Final Office Action at 6 (citing col. 11, 5-30 and col. 8, lines 15-65). Due to the large number of possible choices of optional emollients or surfactants, in addition to all of the requisite picking and choosing, one of ordinary skill in the art could not “at once envisage” selecting an emollient within the scope of the recited “at least one water-insoluble carboxylic acid ester” claim element from among the different classes of possible additives (e.g., surfactants, thickening agents, etc.) disclosed in *Birtwistle*. See M.P.E.P. § 2131.02.

In addition to choosing among those emollients and supplemental surfactants from the disclosure of *Birtwistle*, the skilled artisan would also be required to choose an amount of additive in an attempt to arrive at the presently claimed range of from 1.2 to 8% by weight. *Birtwistle*, however, does not teach the presently claimed range of from 1.2 to 8% by weight of “at least one water-insoluble carboxylic acid.” In relevant part, *Birtwistle* recites that “[t]he cosmetically acceptable vehicle [emollient], **when** present will usually form from 0.01 to 99.9%, **preferably** from 50 to 98% by weight of the compositions, and can, in the absence of other cosmetic adjuncts, **form the balance of the composition.**” *Birtwistle* at col. 11, lines 44-48 (emphasis added). For the case of supplemental surfactants, *Birtwistle* discloses that “[t]he amount of supplementary surfactant **when** present ... is usually up to 50%, preferably from 1 to 40% by weight.” Col. 9, lines 47-49. Whereas a species will anticipate a claim to the genus, “[a] genus does not always anticipate a claim to a species within the genus.” M.P.E.P. § 2131.02. For a disclosed genus to anticipate a claimed species that falls within that genus, anticipation can only be found if one of ordinary skill is able to “at once envisage” that species. *Id.* In this case, the genus of *Birtwistle* does not anticipate the presently claimed range of 1.2 to 8% by weight for at least the reason that the disclosed range of emollients of 0.01 to 99.9% is not sufficiently limited or delineated. Very few amounts of emollient and/or supplementary surfactants are thus excluded from *Birtwistle*’s broad disclosure. In addition, the preferred range of 50-98% for optional emollients of *Birtwistle*, which provides the reader with more focused guidance, does not even encompass the presently claimed range.

The Examiner asserts that example 9 of *Birtwistle* falls within the scope of the present claims stating, “*Birtwistle et al.* teach, in example 9, a body shampoo for use in

the shower or when bathing comprising triethanolammonium mono-(ethyleneglycol-mono-n-decyl ether) phosphate (an anionic surfactant, 10% by weight), triethanolammonium di-(ethyleneglycol-mono-n-octadecenyl ether) phosphate (an anionic surfactant, 8% by weight), cocoamphodipropionate (an amphoteric surfactant, 9% by weight), **ethylene glycol monostearate** (a non-ionic surfactant and water-insoluble ester, 1.5% by weight) and water.” Final Office Action at 9 (emphasis added).

Applicants point out, however, that the present claims were previously amended in Applicants Amendment under 37 C.F.R. § 1.111 dated May 18, 2006, and subsequently entered by the Examiner. Final Office Action at 2. As amended, ethylene glycol monostearate does not fall within the claim scope as a possible water-insoluble carboxylic acid. Accordingly, *Birtwistle* does not disclose any specific examples that recited each and every claim limitation. Instead, the Examiner, as stated on pages 6 and 7 of the Final Office Action, is attempting to find anticipation by combining Example 9 with other discrete disclosures of *Birtwistle*. The Examiner’s reliance on Example 9, and subsequently picking and choosing among the disclosure of *Birtwistle* is precisely the picking and choosing forbidden by *Arkley*. Consequently, the Examiner failed to established a prima facie case of anticipation. Accordingly, this rejection should be withdrawn.

The Examiner has rejected claims 49 and 51 under 35 U.S.C. § 103(a) as allegedly being obvious over *Birtwistle*. Final Office Action at 8. Applicants respectfully traverse this rejection.

“The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness.” *In re Baird*, 16 F.3d 380, 382, (Fed. Cir. 1994); see also M.P.E.P. § 2144.08. Indeed, the

Examiner has provided no other support for his case than that some of the compounds recited in claims 49 and 51 are generally disclosed *Birtwistle*, alleging that one of skill in the art would be motivated to combine the specific disclosure of Example 9 with the broader teachings, i.e, combine the amount of ethylene glycol monostearate (1.5%) in example 9 with any one of the additives general disclosed. Final Office Action at 8-9. However, as already pointed out above, the present claims do not encompass the ethylene glycol monostearate exemplified in that example. Accordingly, one of skill in the art would have no reason to look to the specific teachings of *Birtwistle* to arrive at the present claims. For at least this reason, the Examiner has failed to establish a *prima facie* case of obviousness.

Furthermore, as repeatedly stated on the record, the ranges disclosed for supplemental surfactants, e.g., esters of glycols, such as ethylene glycol monostearate ("up to 50%, preferably from 1 to 40%") and optional emollients ("0.01 to 99.9%, preferably from 50-98%") do not teach or suggest the presently claimed range of 1.2% to 8%. See col. 8, line 63, col. 9, lines 47-49, and col. 11, lines 45-46. Not only does the range for optional emollients of 50-98% actually teach away from the presently claimed range, but also, none of the other ranges provide guidance to suggest to the skilled artisan the claimed range. For this additional reason, the present claims are unobvious over *Birtwistle*.

In view of the foregoing remarks, Applicants respectfully request reconsideration of the current rejections and timely allowance of all pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.